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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,890	03/22/2000	Gian Fulgoni	032838-001	7977
26171	7590	03/31/2005	EXAMINER	
FISH & RICHARDSON P.C. 1425 K-STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/532,890	FULGONI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	James A. Reagan	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 February 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 18-36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

#### DETAILED ACTION

##### Status of Claims

1. This action is in response to the amendment filed on 14 February 2005.
2. Claims 18, 28, 29, 31, 33, and 35 have been amended.
3. Claims 18-36 have been examined.
4. The finality of the previous Office action is hereby withdrawn.

#### RESPONSE TO ARGUMENTS

5. Applicant's arguments received on 26 August 2004 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims. It appears as if the Appellant is attacking the references in a piecewise fashion, instead of in combination, as intended by the Examiner and as shown above in the rejections under 35 USC § 103(a). In response, the Applicant is encouraged to review the rejections again in light of the Examiner's comments below as well as the updated rejections.

Applicant argues that the combination of Chelliah/Pistriotto/Applicant's own admissions do not fairly teach or suggest the newly-added limitations of:

- *the unique identifier is persistent across different network sessions and the network is the Internet,*

- *modifying a browser application on the registered consumer's computer to enable communications sent to and from the registered consumer's computer to be directed through the provider of services located at a domain on the network to record the network activity of the registered consumer*

The Examiner respectfully disagrees, and points to the specification, wherein the Applicant, on page 16 clearly discloses that identification means is already well-known in the art:

"This information may be identifying information provided by a component (either software or hardware) of computer 12, such as by a "cookie" returned to domain 102, a "digital certificate" returned to domain 102, CPU chip identifying information (as has recently been commercially available in Pentium III class chips...or other unique identifying information as will be readily apparent to one of ordinary skill in the art."

In addition, Pistriotto, in at least the abstract and other relevant text, discloses, "The client computer uses the information contained in this message to direct requests messages to a specific caching proxy server based on a category ID," effectively disclosing that the client's browser is modified to be directed to another, separate destination different from the original. In addition, Applicant, in his background discussion of proxy servers beginning at page 11, discloses that proxy server is placed between a client and the Internet, logging and forwarding requests to the intended recipient, clearly disclosing the claimed functionality of the instant invention.

With regard to claims 31 and 32, the Applicant asserts that there is no teaching or suggestion of negotiating separate secure sessions. However, it is obvious that communication between three separate entities requires two communication channels. Since secure communications is already disclosed for one channel, it would be more than obvious to repeat this endeavor for any subsequent channels required to complete the transactions.

With regard to claim 33, the Applicant asserts that there is no teaching or suggestion of a panel of consumers. However, as shown in the rejection below, Applicant discloses that this technique is already known in the art.

With regard to claims 22, 26, and 27, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Applicant either failed to traverse the Examiner's assertion of Official Notice or failed to traverse the Examiner's assertion of Official Notice adequately. To adequately traverse the examiner's assertion of Official Notice, the Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Applicant's assertion of should be included.

#### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
7. Claims 18-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chelliah et al. (US 5,710,887 A) in view of both Pistriotto et al. (US 6,138,162 A) and the Applicant's own admissions.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the

specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 18, 29, 32, and 36:**

Chelliah, as shown discloses the following limitations:

- *offering one or more incentives for prospective consumers to register with a provider of services (see at least column 4, line 17+);*
- *receiving a request at the provider of services from a consumer to register with the provider of services to receive at least one of the offered incentives (see at least column 10, line 18+);*
- *registering the consumer with the provider of services (see at least column 10, line 18+);*
- *assigning a unique identifier to at least one of the registered consumer and a computer of the registered consumer that is connected to a network to record network activity of the registered consumer using the unique identifier at the provider of services (see at least column 26, line 5+);*

Chelliah fails to specifically disclose the limitations shown below. However, Pistriotto and Applicant, as shown, convey the following limitations:

- *directing at least some communications addressed to the destination server on the network from the registered consumer's computer to a server of the provider of services (see at least Applicant's background in the specification , pages 3-5, and Pistriotto, abstract, column 12, lines 37+);*

- *receiving at the provider of services data requests from the registered consumer's computer* (see at least Applicant's background in the specification , pages 3-5, and Pistriotto, abstract, column 12, lines 37+);
- *recording at the provider of services at least part of the received data requests as associated with the unique identifier* (see at least Applicant's background in the specification , pages 3-5, and Pistriotto, abstract, column 12, lines 37+);
- *communicating the received data requests from the provider of services to the destination server capable of fulfilling the received data requests* (see at least Applicant's background in the specification , pages 3-5, and Pistriotto, abstract, column 12, lines 37+);
- *receiving data at the provider of services in response to the received data requests from the destination server* (see at least Applicant's background in the specification, pages 3-5, and Pistriotto, abstract, column 12, lines 37+);
- *recording at least part of the received data as associated with the unique identifier* (see at least Applicant's background in the specification , pages 3-5, and Pistriotto, abstract, column 12, lines 37+);
- *communicating the received data from the provider of services to the registered consumer's computer* (see at least Applicant's background in the specification , pages 3-5, and Pistriotto, abstract, column 12, lines 37+);

With regard to the limitations of:

- *aggregating the received data requests and received data associated with more than one unique identifier based on the recorded network activity of the registered consumers associated with the unique identifiers; and*
- *generating a database by the provider of services of individual and aggregated consumer network activity, wherein the individual consumer network activity includes the received data requests and the received data that is recorded as*

*being associated with the unique identifier, and wherein the aggregated consumer network activity includes the received data requests and the received data that is aggregated as being associated with the more than one unique identifiers;*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the commercial transaction and customer information gathering system of Chelliah with the Applicant's testimony regarding customer incentives, demographic information gathering and internet activity recordation with Pistriotto's proxy server redirect because using a caching servers to intercept and record customer Internet activity and store relevant customer demographics that include Internet activity provide insight to customer behavior and perceptions regarding goods and services provided to online consumers, thereby increasing profitability.

The combination of Chelliah/Pistriotto/Applicant does not specifically disclose aggregating recorded data into a database according to individual customer activity. However, Chelliah, in at least the abstract as well as other related text discloses warehousing customer information data in a database that relates to customer behavior, clearly disclosing that relevant Internet activity by the customer, if deemed valuable, could easily be stored within a customer database for evaluation.

With regard to the limitation of *the unique identifier is persistent across different network sessions and the network is the Internet*, Applicant, on page 16 of the specification clearly discloses that identification means is already well-known in the art:

"This information may be identifying information provided by a component (either software or hardware) of computer 12, such as by a "cookie" returned to domain 102, a "digital certificate" returned to domain 102, CPU chip identifying information (as has recently been commercially available in Pentium III class

chips...or other unique identifying information as will be readily apparent to one of ordinary skill in the art."

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize this technique as disclosed by the Applicant because, as the Applicant testifies, it is already known to those of ordinary skill in the art.

With regard to the limitation of *modifying a browser application on the registered consumer's computer to enable communications sent to and from the registered consumer's computer to be directed through the provider of services located at a domain on the network to record the network activity of the registered consumer*, Pistriotto, in at least the abstract and other relevant text, discloses, "The client computer uses the information contained in this message to direct requests messages to a specific caching proxy server based on a category ID," effectively disclosing that the client's browser is modified to be directed to another, separate destination different from the original. In addition, Applicant, in his background discussion of proxy servers beginning at page 11, discloses that proxy server is placed between a client and the Internet, logging and forwarding requests to the intended recipient, clearly disclosing the claimed functionality of the instant invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Applicant's testimony regarding proxy server functionality with Pistriotto's proxy server redirect because using a caching servers to intercept and record customer Internet activity and store relevant customer demographics that include Internet activity provide insight to customer behavior and perceptions regarding goods and services provided to online consumers, thereby increasing profitability.

**Claim 19:**

Chelliah and the Applicant both disclose incentives. Chelliah/Applicant do not specifically disclose *the offered incentives include at least one of faster network delivery and performing data caching*. However, It would have been obvious to one of ordinary skill in the

art at the time of the invention to use increased bandwidth and faster downloads as an incentive because the structure is a web-based e-commerce system.

**Claims 20 and 21:**

The combination of Chelliah/Pistriotto/Applicant discloses the consumer behavior recording system as shown in the rejections above. Chelliah/Pistriotto/Applicant do not specifically disclose:

- *registering the consumer includes receiving from the consumer personal information about the consumer;*
- *the personal information includes at least one of consumer age, consumer income level, consumer education level, consumer gender and consumer household size;*

However, Applicant, in the background of the specification discloses gathering personal consumer information. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the commercial transaction and customer information gathering system of Chelliah with the Applicant's testimony regarding demographic information gathering and internet activity recordation because recording consumer's personal information provides insight to customer behavior and perceptions regarding goods and services provided to online consumers, thereby increasing profitability.

**Claim 22:**

The combination of Chelliah/Pistriotto/Applicant discloses the consumer behavior recording system as shown in the rejections above. Chelliah/Pistriotto/Applicant do not specifically disclose *the consumer network activity includes transaction information, the transaction information including at least one of time of transmission of a data set, location of computing device, date of transmission of a data set, currency paid, type of product purchased,*

*product purchased, type of service purchased, network address of the intended recipient of a data set, click-through address, banner advertisement impression, and permission e-mail received, and combinations thereof.* However, the Examiner takes Official Notice that it is old and well-known in the online demographic information gathering and transactional arts to associate the aforementioned transactional information with online transactions because this provides an accurate record keeping system, preventing fraud and theft.

**Claims 23 and 24:**

The combination of Chelliah/Pistriotto/Applicant discloses the consumer behavior recording system as shown in the rejections above. Chelliah/Pistriotto/Applicant do not specifically disclose:

- *the recording at least part of the received data includes filtering the received data so that only data of interest is recorded;*
- *the filtering is based on a known format of a web page in the received data;*

However, Applicant, in the background of the specification discloses extracting data from market research endeavors for the purposes of improving company awareness of customer needs, and then using the relevant market research data to change the company in order to achieve its business goals. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the Applicant's philosophy of selecting only consumer behavior data that provides insight to consumer buying habits and excluding misleading or irrelevant data.

**Claim 25:**

With regard to the limitations of *generating a log of the consumer network activity by the provider of services, the log including consumer demographics as well as particular URLs visited by the consumer*, see the rejection of claim 18 above.

**Claims 26 and 27:**

The combination of Chelliah/Pistriotto/Applicant discloses the consumer behavior recording system as shown in the rejections above. Chelliah/Pistriotto/Applicant do not specifically disclose:

- *analyzing the database of consumer network activity to extract estimates of projected revenue of a particular entity;*
- *analyzing the database of consumer network activity to extract estimates of commerce;*

However, the Examiner takes **Official Notice** that it is old and well-known in the online demographic information gathering and transactional arts to extract and extrapolate relevant data to deduce logical insight into customer behavior with the intention of realizing business goals as well as building marketing models which anticipate future consumer behavior in order to change company direction to meet consumer demand.

**Claims 28, 31, and 35:**

The combination of Chelliah/Pistriotto/Applicant discloses the consumer behavior recording system as shown in the rejections above, essentially disclosing the following limitations:

- *when the provider of services receives a request for data in a secure session from a computer of the consumer, negotiating by the server of the provider of services a separate secure session with the computer of the consumer, thus initiating a secure session with computer of the consumer;*
- *communicating the received request for data from a server of the provider of services to the destination server capable of supplying the data;*
- *negotiating by the server of the provider of services another secure session with the destination server for the requested data;*

- *receiving at the server of the provider of services the requested data sent by the destination server during the secure session with the destination server;*
- *recording at least part of the data received from the destination server at the provider of services;*
- *re-addressing the received data for delivery to the computer of the consumer during the secure session between the server of the provider of services and the computer of the consumer, whereby the server of the provider of services securely transfers data to and from the computer of the consumer to the destination server and at a same time monitors the content of the secured data;*

In addition, Applicant discloses Netscape navigator and Microsoft explorer, essentially disclosing the secure socket lay (SSL) protocol, as well as secure online web browsing (see at least page 11 of the specification). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize secure communications to protect against fraudulent behavior.

**Claim 30:**

With regard to the limitation of *provider of services is independent of providers of access to the Internet*, Chelliah discloses Internet and cable providers separately (see at least column 10, line 18+).

**Claim 33:**

The combination of Chelliah/Pistriotto/Applicant discloses the secure consumer behavior recording system as shown in the rejections above, essentially disclosing the following limitations:

- *measuring network activities on a network between computers operated by members of the panel and computers of a multitude of third party providers of services and information on the network,*

- *wherein the measuring of network activities occurs during secure sessions of communication between computers operated by members of the panel computers operated by providers of services and information,*
- *wherein the measuring of network activities occurs at a point on the network between the computers of the members of the panel and a third party provider of network services and information, the point on the network being other than the computers of the members of the panel and computers of third party providers of services and information.*

Chelliah/Pistriotto/Applicant do not specifically disclose *creating a panel of consumers*. Applicant, however, in the background of the specification does. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a consumer panel because this technique would further enable an organization to deduce logical insight into customer behavior with the intention of realizing business goals as well as building marketing models which anticipate future consumer behavior in order to change company direction to meet consumer demand.

**Claim 34:**

The combination of Chelliah/Pistriotto/Applicant discloses the secure consumer behavior recording system as shown in the rejections above. Chelliah/Pistriotto/Applicant do not specifically disclose *the computers of the members of the panel are general purpose computers, and wherein the computers of the providers of services and information are data servers*. Pistriotto, however, in at least the abstract discloses client machines and data caching proxy servers. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the existing client-server architecture of the Internet because it is an established and user-friendly method of communication, exchanging information, and conducting secure transactions.

**Conclusion**

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at **(703) 305-9768**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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After Final communications labeled "Box AF"]

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR

21 March 2005

